

Global and IP5 Patent Prosecution Highway (PPH) Frequently Asked Questions (FAQs)

GENERAL PPH

Q1: What is PPH and how does it help me?

A1:

The Patent Prosecution Highway (PPH) is a framework in which an application whose claims have been determined to be patentable by an Office of Earlier Examination (OEE) is eligible to go through an accelerated examination in an Office of Later Examination (OLE) with a simple procedure upon an applicant's request.

PPH, through the exploitation of all the search/examination-related information of the OEE,

- (1) delivers lower prosecution costs,
- (2) supports applicants in their efforts to obtain stable patent rights efficiently around the world and
- (3) reduces the search/examination burden and improves the quality of the examination of the major patent offices in the world.

Q2: How do I know if my USPTO patent application is eligible for PPH?

A2:

Your USPTO patent application is eligible for PPH if

1) you have received an indication of allowable subject matter in a related application from a partnering PPH office (Click here to see the current list of partnering office http://www.uspto.gov/patents/init_events/pph/index.jsp);

2) the application with the indication of allowable subject matter and your USPTO application share a common earliest priority date;

and

3) examination has not begun on your USPTO patent application

Q3: Is an application filed before the starting date of the PPH program eligible for participation in the program?

A3: yes, as long as the other criteria are met (see Question 2 above).

Q4: Is there a place where I should look for a complete listing of PPH participating countries?

A4:

The complete list of PPH participating countries is available at:
http://www.uspto.gov/patents/init_events/pph/index.jsp.

In addition, the USPTO has worked closely with the JPO to create a one-stop PPH information portal, hosted on the JPO website (www.jpo.go.jp). At this portal, applicants can find relevant information about all current PPH programs, including up-to-date statistics and fillable request forms.

Filing a PPH Request

Q5: How do I enter PPH at the USPTO?

A5: In order to have your application considered for PPH you must meet all the criteria (see Question 2 above) and submit a PPH Request Form. Click here for a list of PPH Request forms (http://www.uspto.gov/patents/init_events/pph/index.jsp);

Q6: The PPH notices indicated that the PPH papers must be submitted via EFS-Web. What document description should I use to submit the PPH request?

A6:

The document description for the PPH request is "Petition to make special under Patent Pros Hwy."

For the IDS accompanying the PPH request, the document description is "Information Disclosure Statement (IDS)." For the preliminary amendment accompanying the PPH request, the document description is "Preliminary amendment."

Q7: The notices regarding the PPH programs state that if a copy of the office action from the OEE application(s) is available via the Dossier Access System, applicant may request that the USPTO obtain the copy via the Dossier Access System. Please advise how an applicant could find out whether an OEE office action is available via the Dossier Access System or not.

A7:

Applicant can determine the availability of the office action by checking the Dossier Access System Web site at <http://www.jpo.go.jp/ppph-portal/filewrapper.htm> and the PATENTSCOPE system of the World Intellectual Property Organization (WIPO) at <http://patentscope.wipo.int>. In certain cases, the dossier can be accessed only by intellectual property offices and not by the public. If applicant is unable to determine whether the OEE work product is available via the Dossier Access System or PATENTSCOPE, applicant should provide a copy of the OEE work product.

Q8: If an English translation of the OEE work product is required, is a machine translation sufficient?

A8: The English translation may be a machine translation. However, if the USPTO finds the machine translation is of such poor quality that it is difficult to understand, the applicant may be required to submit a manual translation.

PPH Scenarios and Program Specifics

Scenario A: I understand that a PPH request may not be filed after examination of the US application has begun. Does this mean substantive examination? In other words, can a PPH request be filed after the USPTO has reviewed the US application for formalities only (for example, a Notice to File Missing Parts is mailed)? Can the PPH petition be filed after an applicant has received a restriction requirement but before receipt of the first office action on the merits?

Answer to Scenario A:

The requirement that examination of the US application must not have begun refers to substantive examination. Therefore, if you have only received a notice to file missing parts, this would not be considered as substantive examination. If you have received a restriction requirement in the US application, your US application may still be eligible to participate in the PPH program if the examiner has not started on the first action on the merits. However, at this point in time, you may not need PPH since your application will not be examined any faster than its normal examination process even if your PPH request is granted. With a restriction requirement, our examiner will generally examine the application within 60 days from the date you file your reply to the restriction requirement. By the time your PPH request is decided, your application would probably be examined in its regular turn anyway.

Scenario B: If an application is recognized as eligible for the PPH, is the application going to be granted without a substantive examination?

Answer to Scenario B:

No. Substantive examination under the PPH is conducted according to the US law and guidelines in the same way as non-PPH applications. While there is no guarantee that the result of the USPTO examination will match that of the OEE, in most cases PPH applications return tremendous benefits to the user in terms of delivering lower prosecution costs, providing stable patent rights efficiently around the world, reducing the search/examination burden and improving the quality of the examination of the major patent offices in the world.

Scenario C: A US application claims foreign priority to an OEE application. The OEE application has received allowable claims. The US application has received a first office action on the merits. Would it be possible to use the PPH program for a new US continuation or divisional application?

Answer to Scenario C:

Yes, if you choose to file a US continuation/divisional application, the continuation/divisional application may be eligible to participate in the PPH program based on the allowable claims from the OEE application.

Scenario D: I am filing a national stage entry into the US of a PCT application. Can I file the PPH request form simultaneously with the national stage entry papers? What is the required application number? What is the proper filing date?

Answer to Scenario D:

If you are entering national stage into the US based on a PCT application, there is no requirement that you file your PPH request with the filing of the national stage papers. It is not necessary to file your PPH papers so early because even if your PPH request is granted, our examiner cannot examine your application as special until the application has completed all its pre-exam processing. It is suggested that you wait until at least you get your US application number so that you can identify the US application number on the PPH request before you file your PPH papers. Note that the filing date of a national stage entry into the US of a PCT application is the international filing date (see 35 U.S.C. 363).

Scenario E: How much quicker will an application proceed to grant if a PPH request is filed at the USPTO? Is there a similar goal of final disposition as in Accelerated Examination (AE)?

Answer to Scenario E:

The PPH program does not have a similar goal of final disposition of 12 months as in the AE program. The PPH program does not require the request to be filed at the time of filing of the application as in the AE program. The PPH program does not expedite the pre-exam processing as in the AE program. Under the PPH program, applicant chooses when to file the PPH papers. Once the PPH request is filed, the PPH request is generally decided within 2 months from the filing of the PPH request. If the PPH request is granted, the examiner will generally examine the application within 2 to 3 months from the grant of the PPH request provided the application has completed all its pre-exam processing and is ready for examination.

Scenario F: The first action in the OEE application is a first action allowance. In the Decision to grant, the OEE examiner cited several references. Should I submit an IDS listing those references, even though there was no rejection?

Answer to Scenario F:

Although the submission of an IDS in this scenario would not be an explicit requirement of the PPH program, applicant still has a duty to bring to the attention of the Office any material prior art or other information cited or brought to applicant's attention in any related foreign application. See MPEP 2001.06(a).

Scenario G: When the documents cited in an IDS are in a foreign language, are applicants required to provide an English translation of the documents?

Answer to Scenario G:

The IDS must comply with the content requirements of 37 CFR 1.98. That is, if the documents are not in English, you will need to submit a concise explanation of the relevance pursuant to 37 CFR 1.98(a)(3). Where the document listed on the IDS is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office (see MPEP 609.04(a), subsection III.).

Scenario H: If a new US application is accepted in the PPH program, is Patent Term Adjustment (PTA) still available to the US application?

Answer to Scenario H:

PTA is available to applications accepted in the PPH program.

Scenario I: Are extensions of time under 37 CFR 1.136(a) available for applications accepted in the PPH program?

Answer to Scenario I:

Yes. You may obtain extensions of time under 37 CFR 1.136(a) during prosecution of the US application accepted in the PPH program.

Scenario J: I recently filed a PPH request and upon review noted that there were errors on the PPH request. With regard to the PPH request error, is it possible to amend the error before I receive a decision on the PPH request?

Answer to Scenario J:

If you have not received a decision on your PPH request, it is suggest that you submit a corrected PPH request form via EFS-Web as soon as possible. In addition, you should also submit a transmittal letter with these documents explaining that the earlier-filed PPH request contained errors and the replacement documents corrected the errors. If you have already received a decision on the PPH request, in your reply to the PPH decision you should submit the corrected PPH request form. You should also submit a transmittal letter explaining the errors that you are correcting in the replacement PPH request form.

Scenario K: Can I rely on the allowed claims from a utility model or an innovation patent from an OEE to form the basis for requesting PPH in the USPTO?

Answer to Scenario K:

With one exception, the answer is no. Utility models and innovation patents as a general matter are not required to meet the same patentability standards as regular (utility) patents, and typically are not subjected to substantive examination. An exception has been made for Korean utility models (see notice available at <http://www.uspto.gov/web/offices/com/sol/og/2009/week08/TOC.htm#ref14>). The USPTO continues to consider practices in other countries with regard to possible inclusion in the future of similar types of applications, but has made no decisions as such at this time.

Scenario L: Can you provide some information/explanation about what is meant by “a positive Extended European Search Report”?

Answer to Scenario L:

The EPO generates an Extended European Search Report (EESR) prior to an office action. If the EESR only contains “A” references (no “X” or “Y” references) directed to a particular claim then that claim is considered to be allowable by the EPO. You will be able to use that EPO allowable claim as the basis for

your PPH request in the US application. All the claims in the US application must sufficiently correspond to that EP allowable claim.

Scenario M: The notices regarding PPH indicate that US claims will be considered to *sufficiently correspond* with the claims allowed by the OEE if the US claims are of the same or similar scope or the US claims are narrower in scope than the allowed claims. The additional limitation that makes the US claims narrower in scope than the allowed claims must be presented in dependent form. Can applicant incorporate the narrower dependent claim into the independent claim during the US prosecution if the independent claim which has the same scope as the allowed claim was rejected by the US examiner but the narrower dependent claim was objected to as being dependent on a rejected claim?

Answer to Scenario M:

If the narrower dependent claim is indicated as being allowable if written in independent form, you may rewrite the allowable dependent claim in independent form.

Scenario N: If an independent claim which sufficiently corresponds to an allowed claim in the OEE work product is rejected by the US examiner but may be allowable if amended to include some additional limitation, will such an amendment meet the sufficient correspondence requirement?

Answer to Scenario N:

Yes, but only if the limitation was one previously presented in a dependent claim that is indicated as having allowable subject matter but objected to only because it is dependent on a rejected base claim.